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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lucent Technologies, Inc.

Serial No. 75/045,569

R. A. Ryan for Applicant.

Deborah E. Lobo, Trademark Examining Attorney, Law Office
107 (Thomas S. Lamone, Managing Attorney).

Before Simms, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lucent Technologies, Inc., by assignment from NS-MPG
Inc., is the owner of an application to register the mark
"ULTIMAX" for "telecommunications products, namely, outside
plant¹ structured cabling system consisting of copper,
coaxial and fiber optic cable, cabinets, enclosures, cable

¹ According to applicant, "outside plant" is a commonly-used
term for the part of a large organization's telephone system that
is physically located outside the corporate buildings.

connectors, composite cable and cable connectors, central office cable terminating devices, and telecommunications network interface devices."²

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's proposed mark, "ULTIMAX" when used on these high-technology items in the nature of outside plant cabling infrastructures, so resembles the registered mark, "ULTIMAX," as applied to "transient voltage suppressors and conditioners" as to be likely to cause confusion, or to cause mistake, or to deceive.³

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We reverse the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont DeNemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

² Serial No. 75/045,569, in International Class 9, filed January 18, 1996, based upon an allegation of a *bona fide* intention to use the mark in commerce.

³ Registration No 1,805,173, issued on November 16, 1993. The registration sets forth dates of first use of June 11, 1992.

Identical Marks

The examining attorney focuses first on the similarities of the two marks. In its brief, applicant concedes the obvious -- applicant's mark "ULTIMAX" is identical in appearance, sound, connotation and commercial impression to registrant's mark "ULTIMAX." Thus, the issue of whether confusion is likely under the Trademark Act will turn on a weighing of all the relevant du Pont factors.

Relatedness of the respective parties' goods

These marks must be considered in connection with the particular goods for which they are, or will be, used. In re National Data Corp., 224 USPQ 749, 750 (Fed. Cir. 1985). Hence, the examining attorney proceeded to a comparison of the respective parties' goods to determine if they are, or will be, related. We agree with the Trademark Examining Attorney that for the purpose of determining likelihood of confusion, the goods need not be identical or even competitive. It is sufficient that the goods or services of the applicant and registrant are related in some manner that would give rise to a likelihood of confusion. See e.g., In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Corning Glass

Works, 229 USPQ 65 (TTAB 1985); In re Jeep Corp., 222 USPQ 333 (TTAB 1984).

Throughout the prosecution of this application, applicant has consistently construed the goods covered by the registration in a most narrow context. As a result, applicant asserts that these respective goods are not at all similar. In fact, applicant identifies registrant's product as an A/C surge protector for appliances and electronics having A/C power connections. This is a more restrictive variant than "transient voltage suppressors and conditioners" as set out in the registration. Applicant first made this assertion in its first response to the initial Office action refusing registration. Applicant then followed up this argument by submitting with its appeal brief additional materials about registrant's goods tending to support this restrictive identification.⁴ Since applicant did not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal,⁵ we agree with the

⁴ Applicant submitted as attachments information from the specimen included with registrant's Statement of Use (dated July 16, 1993) as well as some of registrant's pamphlets, purporting to show that registrant's products are marketed to consumers wishing to protect appliances and electronic equipment such as TV's, VCR's, stereo systems, computers, fax machines, and copiers from power surges.

⁵ See, 37 CFR 2.142(d); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

Trademark Examining Attorney that this material cannot enter into our decision. Accordingly, and for the reasons indicated more fully below, we cannot share in applicant's assumption that the registrant's goods are designed exclusively for indoor use or used exclusively with domestic appliances and electronics. We conclude that these goods *could* be complementary products as demonstrated by the Trademark Examining Attorney using a broad definition of registrant's goods.⁶ See *Communications Satellite Corp. v. Comcet Inc.* 166 USPQ 353, 358 (4th Cir. 1970) (complementary products are particularly vulnerable to confusion).

Trade Channels

Given identical marks and arguably complementary goods, the Trademark Examining Attorney contends that the same purchasers would encounter these marks, and that the activities surrounding their marketing are such that

⁶ Without reference to the untimely attachments provided by applicant with the appeal brief, we accept that by definition, the signals conducted by applicant's telecommunications cable products do not include Alternating Current (A/C) electrical power. We agree with applicant, at least on this record, that a manufacturer of surge protectors for indoor or outdoor A/C appliances would not be likely to manufacture state-of-the-art products for the telecommunications industry. Any manufacturer of registrant's A/C products would be venturing into an entirely different line of business if it were to begin manufacturing products for the transmission of video, data and telephone signals via coaxial or fiber-optic telecommunications cables.

confusion as to origin is likely.⁷ Based on this evidence, the Trademark Examining Attorney concludes that registrant's goods might well include voltage suppressors and conditioners designed for use in conjunction with outside telecommunication structures and equipment. We agree with the Trademark Examining Attorney that registrant's identification of goods is not limited in any manner and must necessarily be read to encompass all of the normal trade channels and customers of any type, of any price, or for use with any "transient voltage suppressors and conditioners."

By contrast, applicant concludes that the channels of trade for the goods are different. Applicant argues that purchasers seeking quite different products to satisfy very different requirements will naturally seek those products in distinctly different channels of trade.

⁷ The Trademark Examining Attorney has submitted evidence in the form of NEXIS articles, listing from the Thomas Register of American Manufacturers, and third-party registrations to demonstrate that transient voltage suppressors and conditioners are related to outside cabling systems. For example, she argues that cabling systems are likely to include voltage suppressors as a means of protecting the affected telecommunications equipment from electrical surges. She argues further that all cables inside the plant are ultimately linked to outside cabling systems. Moreover, she contends that the term "devices" used in applicant's identification of goods, i.e., "central office cable terminating devices and telecommunications network interface devices," is actually broad enough to encompass voltage suppressors and conditioners.

We conclude that there is significant dissimilarity between applicant's products and registrant's listed goods. When comparing applicant's products to registrant's goods, even the Trademark Examining Attorney admits these goods are likely different. On the current record, we cannot say for sure whether these goods might be complementary. The Trademark Examining Attorney and applicant seem to agree that registrant's and applicant's goods are electrical and telecommunications devices, respectively, possibly used by the same large institutions inside the offices and outside the plant. However, the fact that these respective goods could possibly be complementary products does not exhaust the du Pont factors that are relevant herein. Furthermore, we are not convinced that the goods as recited in the application and registration would necessarily move in the same channels of trade, and it would be premature to conclude that the use by applicant of "ULTIMAX" in connection with its products is likely to cause confusion with registrant's mark.

Conditions of Sale / Sophistication of Purchasers

Applicant's products are outside plant structured cabling systems that are marketed to service providers interested in constructing telecommunications networks. We

accept from the identification of goods that applicant's products are most expensive and are provided only to sophisticated professionals on an individualized basis. Even though this may not be true of registrant's goods, this factor weighs against finding a likelihood of confusion. See Industrial Nucleonics Corporation v. Hinde, 475 F.2d 1197, 1199, 177 USPQ 386, 387 (CCPA 1973), and Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir. 1983) (sophisticated purchasers and expensive goods militate against confusion). Accordingly, applicant argues that the sophisticated purchasers making decisions about procuring applicant's products would definitely not be likely to confuse the source of the respective vendors' goods.

With respect to the sophistication of the relevant purchasers, the Trademark Examining Attorney correctly points out that courts have recognized that buyer expertise does not always assure the absence of confusion, especially when one is faced with identical marks. However, under all the facts of this case, we conclude that this potential for confusion appears to be a mere possibility -- not a probability. See Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794, 804, 167 USPQ 713, 720 (9th Cir. 1970). As discussed in more detail below, the number of persons

who actually fall into the category of overlapping purchasers appears *de minimis* at best.

The Trademark Examining Attorney postulates that a corporate office purchasing registrant's indoor voltage suppressors for its corporate operations may also need to consider purchasing outdoor telecommunications equipment of the type sold by applicant. We do not agree.

Applicant and registrant conduct business in somewhat related fields and one could hypothesize that they might well sell products to some of the same large institutions. However, the mere possibility of purchase of the goods of both vendors by the same institution does not, by itself, establish similarity of trade channels or overlap of customers. For example, individual departments may be quite independent in their respective purchasing activities. In such large organizations, it can hardly be presumed that expensive and sophisticated infrastructures such as outside plant cabling are selected by the same individuals who make routine purchases of office supplies, including power protection devices. Astra, 718 F.2d at 1206, 220 USPQ at 790. The likelihood of confusion must be shown to exist not in a purchasing institution, but in "a customer or purchaser." *Id.*, 220 USPQ at 790. As the Court of Customs and Patent Appeals stated in Witco Chem. Co. v.

Whitfield Chem. Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g, 153 USPQ 412 (TTAB 1967):

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.

The facts of this case are similar in some respects to those found in the cases of Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) and Dynamics Research Corp. v. Langenau Manufacturing Co., 704 F.2d 1575, 217 USPQ 648 (Fed. Cir. 1983). As is the case here, the marks involved in Electronic Design ("E.D.S. and design" compared to "EDS") and Dynamics Research (both marks comprise the initialism "DRC") were virtually identical. However, as was the situation in these prior two cases, the record herein establishes that applicant's goods are expensive. They would be purchased by experienced corporate officials following significant study and contractual negotiation:

In those instances where the same customers might be exposed to both applicant's and opposer's goods sold under the identical mark, there would not be any likelihood of confusion as to the source of the goods in view of the nature of the goods involved and the nature of the purchasers [large corporations and government agencies] who would be responsible for acquisition of the products.

Dynamics Research, 217 USPQ at 650.

Inasmuch as applicant's products (as described) must be assumed to be targeted to a most discriminating clientele, probably under a negotiated contract involving many thousands of dollars and a close working relationships with the customer, it is highly unlikely that a sophisticated client interested in Lucent Technologies' products would think that "ULTIMAX" surge protectors also represent applicant's goods.

Conversely, we agree with applicant that the average consumer wishing to purchase a surge protector would be extremely unlikely to know of applicant's outside plant network cabling system.

How diluted is the mark?

While applicant's mark and registrant's mark are virtually identical, this highly suggestive matter cannot be deemed to be a strong mark. Applicant has submitted Patent and Trademark Office printouts (pending applications and registrations) of a dozen variations on the ULTIMAX formative, including use on electrical cables, electronic controls, and portable temperature sensing systems. Although there is no evidence of use of these third-party

marks, we may look at this kind of evidence to show probable meaning or connotation of the mark.

Variety of goods on which registrant's mark is used

We agree with applicant that there is not a reasonable probability, based upon the field of manufacture registrant currently occupies, that registrant would enter the field of manufacturing telecommunications products.

Decision: In spite of identical marks used on potentially complementary goods, we conclude that based upon the relative weakness of this mark, the expense of applicant's goods, the sophistication of applicant's purchasers, and an absence of any clear overlap in purchasers of the respective parties' goods, confusion is not likely. The refusal to register under Section 2(d) is reversed.

R. L. Simms

P. T. Hairston

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board